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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Patent No. 6,708,221
Inventors: Mendez et al.
Filed: September 20, 2000
Issued: March 16, 2004

Title: SYSTEM AND METHOD FOR GLOBALLY AND SECURELY ACCESSING UNIFIED INFORMATION IN A COMPUTER NETWORK

SUBMISSION OF PRIOR ART UNDER 35 U.S.C. 301 AND 37 CFR 1.501

Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SUBMISSION OF PRIOR ART UNDER 35 U.S.C. § 301 AND 37 CFR § 1.501

Dear Sir or Madame:

Research In Motion Limited ("RIM") presents this citation and explanation of pertinence of prior art that has a bearing on the patentability of certain allowed claims of U.S. Patent No. 6,708,221 ("the '221 patent"), under 35 U.S.C. § 301 and 37 CFR § 1.501. Specifically, the teachings of the Mowser and Tso references, both of which the Patent Owner is aware of, have not been submitted to the PTO in spite of being material to the patentability of at least claim 63 of the '221 patent. In addition, an Examiner has determined in a related copending reexamination that Lotus Notes teaches all the limitations of at least claim 72. These references and the other prior art cited below are "pertinent and applicable to the patent" in accordance with MPEP § 2205. Although there are ongoing reexamination proceedings for the '221 patent, this submission is made "separate from and without a request for reexamination." MPEP § 2202.

In the merged reexamination proceedings, the Examiner indicated new claims 63 and 72 were each allowable in light of the addition of a single limitation. See Ctrl. No. 90/008,131. The prior art cited herein is material to the patentability of both claims. RIM requests that this explanation of the pertinence and manner of applying these references becomes part of the official file for the '221 patent under 35 U.S.C. § 301 and 37 CFR § 1.501.

Claim 63

In the merged reexamination proceeding for the '221 patent, claim 63 was found to recite allowable subject matter in view of a single added limitation. The Examiner stated in his reasons for allowance that the prior art relied upon in the request does not disclose the claim 63 limitation of "receiving interface preferences of a predetermined user from the global server and configuring the second device according to said interface." *See* Ctrl. No. 90/008,131 non-final Office action dated 1/16/2009 at pg. 117.

The following references bear on the patentability of at least claim 63:

- Anupam Joshi, et al., Mowser: Mobile Platforms and Web Browsers, Univ. of Purdue ("Mowser") – Attached as Exhibit A
- GloMop Group, GloMop: Global Mobile Computing By Proxy, Univ. of Ca. at Berkley (Sept.1995) ("GloMop") – Attached as Exhibit B
- U.S. Patent No. 6,047,327 ("Tso") – Attached as Exhibit C

An explanation of pertinency of these references to the subject matter found to be allowable is provided below.

Mowser

'221 Claim 63	Analysis of Mowser	Disclosure of Mowser
wherein the second device receives interface preferences of a predetermined user from the global server and configures the second device according to the interface preferences.	Mowser discloses storing user preferences at a preferences server. Mowser at p. 4, § 2.2. The preferences are accessible by the mobile host (MH) from anywhere. Mowser at p. 3, § 2.1. The preferences can be used to configure the MH (*e.g.*, the proxy server starts a browsing session on the client and starts the URL defined in the preferences). Mowser at p. 4, § 2.2.	"The current implementation uses two Web servers running on a static machine, one that stores preferences for all its MHs (preferences server) and another that proxies all HTTP requests from the MH (proxy server)." **Mowser at p. 4, § 2.2.** "Each mobile host's preferences WWW are known to this server. They are stored according to the mobile host's IP address, allowing the MH to access them from anywhere. The preferences file contains information about the hardware capabilities of the MH, and its user preferences." **Mowser at p. 3, § 2.1.** "The preferences server has two functions, to get the preferences for a MH at the start of a browsing session, and to update them whenever

		the user requests so. [...] Once the preferences are stored, the proxy server starts the browsing session by loading the starting URL defined in the preferences." **Mowser at p. 4, § 2.2.**

GloMop

'221 Claim 63	Analysis of GloMop	Disclosure of GloMop
wherein the second device receives interface preferences of a predetermined user from the global server and configures the second device according to the interface preferences.	GloMop discloses negotiating with a client to determine a distillation process to reduce the quality of a requested file based on the user's preference. GloMop at p. 3, § 1.3. Further, the client can delegate any functions to the network, such as configuring the user interface of the client. GloMop at p. 8, § 3.1.	"Simply put, *distillation* can be thought of as lossy compression that preserves enough semantic information to make a document useful while making the document drastically smaller and easier to render on the mobile client, and possibly exploiting the document's semantic structure. [...] **Example: Graphic image.** We can reduce the area or the color palette or both for a large full-color graphic. For example, we reduced an 8-bit-color, full-screen (VGA) GIF image to a thumbnail-sized 4-gray image for display on a Sony MagicLink PDA." **GloMop at p. 3, § 1.3.** "Furthermore, it should be possible for the client application to delegate management of any property to the network software, rather than managing it explicitly." **GloMop at p. 8, § 3.1.**

Tso

'221 Claim 63	Analysis of Tso	Disclosure of Tso
wherein the second device receives interface preferences of a predetermined user from the global server	Tso discloses sending a client configuration message to a client; the configuration message includes location information for determining the type of information that the client	"As client A 23 enters California, server A 17 is responsible for updating client resource database 71 and client content database 72 of client A 23 through the use of a client configuration message through which clientA23 can optionally retrieve a state map of California. Alternatively, server A 17 can automatically send client A 23 the map.."

| and configures the second device according to the interface preferences. | displays on the InfoFeed interface. Tso at col. 12, lines 11-18 and col. 6, line 64- col. 7, line 8. | **Tso at col. 12, lines 11-18.**

"InfoFeed interface 57 enables content providers to update data and resources on server A 17 for specific subscriber locations and times. Thus, content providers may feed information only to those InfoCast servers matching a specific criterion. For example, content provider A 5, while sending news events which are global in nature to the InfoCast server in California, can also limit the type of weather information that is sent to the California InfoCast server to weather conditions which are local to California. InfoFeed interface 57 can also actively contact a content provider over network A 3 without initial contact from the content provider so as to "search" the internet for new content which might be interesting to users of the system." **Tso at col. 6, line 64 – col. 7, line 8.** |

Addition of the limitation "receiving interface preferences of a predetermined user from the global server and configuring the second device according to said interface" is apparently the reason the Examiner allowed claim 63 of the '221 patent. Because Tso, Mowser and GloMop are therefore material to patentability, RIM requests that this explanation of the pertinence and manner of applying these references becomes part of the official file for the '221 patent under 35 U.S.C. § 301 and 37 CFR § 1.501.

Claim 72

In the merged reexamination proceeding for the '221 patent, claim 72 was found to recite allowable subject matter in view of the addition of a single limitation. The Examiner stated in his reasons for allowance that the prior art relied upon in the request does not disclose the claim 72 limitation of "receiving at the service server, a service request from the global server and wherein the first device is located within a LAN, the second device and global server are outside the protection of the LAN firewall and the service server is located within the LAN." *See* Ctrl. No. 90/008,131, non-final Office action dated 1/16/2009 at pg. 117.

In the reexamination of the related U.S. Patent No. 6,708,192, the Examiner found a claim containing a similar limitation was unpatentable based on Lotus Notes, including Brown. Ctrl. No. 90/008,062, non-final Office Action dated 7/3/08 at pgs. 53-54.

The following references therefore bear on the patentability of at least claim 72:

- Brown, Kevin et al., <u>Mastering Lotus Notes</u>, 1995 Sybex Incorporated. ("Brown") – Attached as Exhibit D

- Lamb, John P. and Lew, Peter W., <u>Lotus Notes Network Design</u>, 1996 McGraw-Hill. ("Lamb") – Attached as Exhibit E

An explanation of pertinency of these references to the subject matter found to be allowable in the '221 reexamination is provided below.

<u>Lotus Notes</u>

'221 Claim 72	Rejected '192 Claim 32[1]	Analysis of Brown and Lamb
wherein the first device is located within a local area network (LAN) protected by a LAN firewall, the second device is outside the protection of the LAN firewall, the global server is outside the protection of the LAN firewall, the service server is located within the LAN.	"wherein the first store is on a service server located in a LAN protected by the firewall,…a communication channel coupling the first store to a third store outside the protection of the firewall, the third store being coupled to the second store by a further communication channel." Control No. 90/008,062, non-final Office Action dated 7-3-08 at pgs 53-54 (discussing claim 32).	"Brown discloses the use of a Lotus Notes Server (page 8) and a plurality of client [sic] (first, second and third stores)…Since each data store is connected to the Lotus Notes Server then ultimately the first store is connected to the second store which is then coupled to the second store by separate communication channels." Control No. 90/008,062, non-final Office Action dated 7-3-08 at pgs 53-54). In addition, Fig. 2.1 of Lamb, shown below, discloses a Lotus Notes network depicting all the devices in the allegedly patentable limitation of claim 72.

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[1] Claim 32 in the '192 reexamination proceeding was later found patentable over Brown due to the inclusion of smartphone in claim 32, which is not claimed in allowed claim 72 of the '221 reexamination
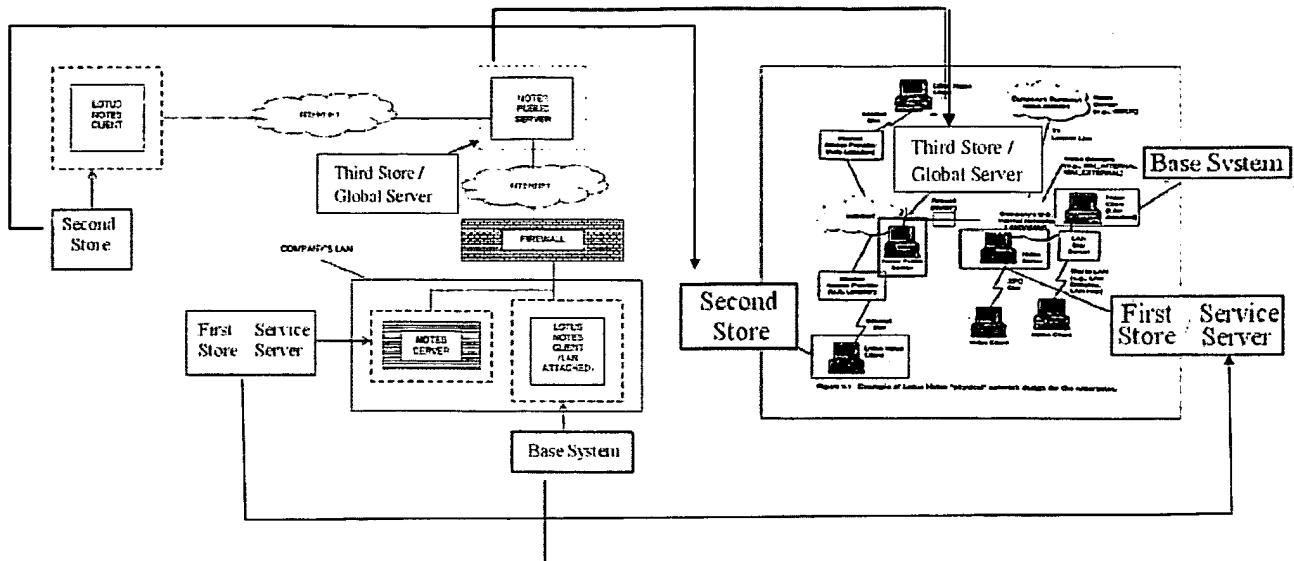
Analysis of Fig. 2.1 of Lamb

Addition of the limitation "receiving at the service server, a service request from the global server and wherein the first device is located within a LAN, the second device and global server are outside the protection of the LAN firewall and the service server is located within the LAN" is apparently the reason the Examiner allowed claim 72. As the Examiner found in the '192 reexamination, Brown and Lamb teach that this limitation was present in the prior art Lotus Notes system. The only reason for allowance of claim 32 in the '192 reexamination over Lotus Notes was due to the inclusion of smartphone in the claims, which is not claimed in claim 72 of the '221 reexamination.

Conclusion

Mowser, GloMop, Tso, Brown and Lamb cited in this submission are "pertinent and applicable to the patent" in accordance with MPEP § 2205. Although there are ongoing reexamination proceedings for the '221 patent, this submission is made "separate from and without a request for reexamination." MPEP § 2202.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this submission under 35 U.S.C. § 301, together with all exhibits and attachments and supporting documentation, has been served via first class mail on the 20th day of March 2009, upon the following:

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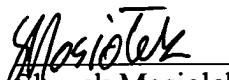
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